

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-11 are pending in the application, with claims 1 and 8-11 being the independent claims. Claims 3 and 5-11 are withdrawn from consideration by the Examiner.

Support for amendment to claims 1 and 2 can be found in the originally filed claims 1 and 2. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. Supplemental Information Disclosure Statement

Applicants note that a First Supplemental Information Disclosure Statement is submitted accompanying the Amendment and Reply. Applicants respectfully request the Examiner initial and return a copy of Information Disclosure Statement Forms.

II. Objections

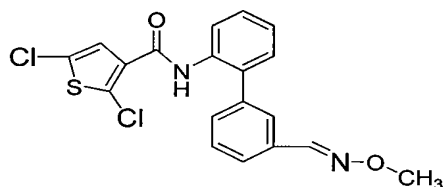
Claims 1, 2 and 4 were objected for containing non-elected subject matter. The amendment to claims 1, 2 and 4 herein renders this objection moot.

III. Rejoinder

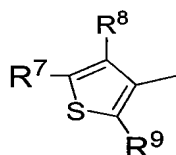
Upon allowance of elected claims 1, 2 and 4, Applicants respectfully request rejoinder of method claim 6 to the elected invention.

IV. Rejections under 35 U.S.C. § 103

Claims 1, 2 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO02/08197, which is equivalent to U.S. Patent No. 7,176,228 B2 ("the '228 patent"). The Examiner stated that the '228 patent discloses the following compound (Example No. 100):



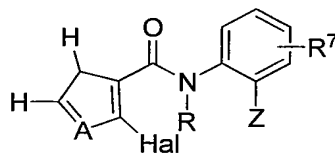
The Examiner also stated that the '228 patent describes preferred substituents in the thiophene ring, including R⁷ being hydrogen:



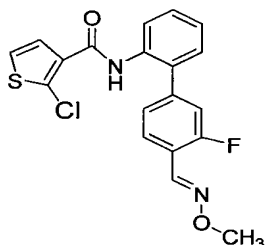
The Examiner further stated that "[t]he prior art discloses that R7 could be hydrogen, thus suggesting the instantly claimed species." (Office Action, page 8.)

According to the Examiner, "[o]ne skilled in the art would have also found the claimed compounds *prima facie* obvious in light of US 7,176,228 B2 because the instantly claimed compounds and the compounds of US 7,176,228 B2 have the same core structure, that of a 2'-phenyl-2-chlorothiophene-3-carboxaniline. The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity." (Office Action, pages 8-9.) Applicants respectfully disagree.

Amended claims 1, 2 and 4 of the present application require a compound of following formula,



wherein A is O or S, Z is Z¹, Z², Z³, or Z⁴, and Z¹ is phenyl which is optionally mono- to pentasubstituted by identical or different substituents W¹, **provided that** when Z¹ is mono-substituted by -CH=N-OCH₃, said phenyl is further substituted by at least one halogen atom, such as fluorine, as illustrated by Compound No. 40 of the present application. *See* the application at page 77.



(Compound No. 40)

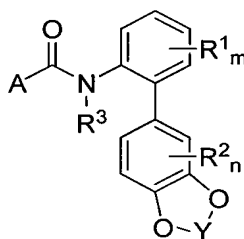
Thus, amended claims 1, 2 and 4 require a compound which is structurally **dissimilar** to the compound described in the '228 patent. Specifically, the '228 patent does not disclose a species that is encompassed by the amended claims 1, 2 and 4. In addition, the Examiner has not provided a reason why one would substitute the phenyl ring containing the group -CH=N-OCH₃ by a halogen atom. Accordingly, Applicants respectfully submit that the amendment to claims 1, 2 and 4 herein renders this rejection moot.

V. Nonstatutory Double Patenting Rejections

A. Double Patenting Rejection over U.S. Patent No. 7,208,169

Claims 1, 2 and 4 were rejected on the ground of non-statutory double patenting over claims 1-4 and 7-8 of U.S. Patent No. 7,208,169 ("the '169 patent"). According to the Examiner, "the patent [the '169 patent] and the application are claiming common subject matter, as follows: A represents S (sulfur) or O (oxygen); M represents phenyl and wherein Z is Z1 and Z1 represents optionally substituted phenyl." (Office Action, page 10.)

Claims 1-4 and 7-8 of the '169 patent are directed to a compound of formula (I):

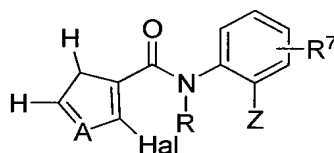


in which

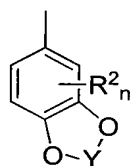
...

wherein Y represents carbonyl or represents C_1 - C_3 -alkylene which is optionally mono- or polysubstituted by identical or different substituents from the group consisting of halogen, C_1 - C_6 -alkyl, C_1 - C_6 -alkoxy, C_1 - C_6 -alkylthio, C_1 - C_6 -haloalkyl having 1 to 13 fluorine, chlorine, and/or bromine atoms, C_1 - C_6 -haloalkoxy having 1 to 13 fluorine, chlorine, and/or bromine atoms, and C_1 - C_3 -haloalkylthio having 1 to 13 fluorine, chlorine, and/or bromine atoms. . . .

Amended claims 1, 2 and 4 of the present application require a compound of following formula:



wherein A is O or S, Z is Z¹, Z², Z³, or Z⁴, and Z¹ is phenyl which is optionally mono- to pentasubstituted by identical or different substituents W¹. None of Z¹ as recited in claims 1, 2 and 4 of the present application is the same or similar to the corresponding group as required in claims 1-4 and 7-8 of the '169 patent:



Thus, claims 1, 2 and 4 of the present application and claims 1-4 and 7-8 of the '169 patent are directed to different subject matters. Accordingly, Applicants respectfully submit that the amendment to claims 1, 2 and 4 herein renders this rejection moot.

B. Provisional Double Patenting Rejection

Claims 1, 2 and 4 were provisionally rejected on the ground of non-statutory double patenting over claims 15-26 of co-pending Application No. 10/538,242; claims 1-4 of co-pending Application No. 10/579,033; claims 1-4 of co-pending Application No. 10/597,723; and claims 1-4 of co-pending Application No. 12/097,753.

Applicant will address these provisional non-statutory double patenting rejections when the claims of the present application or the relevant claims of any one of the co-pending applications are allowed.

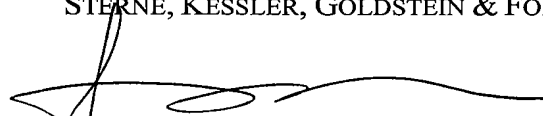
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to be 'Lei Zhou', written over a horizontal line.

Lei Zhou
Attorney for Applicants
Registration No. 48,291

Date: May 4, 2009

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

969543_2.DOC